

REMARKS

Initially, Applicants have amended claims 168, 171, 189, 191, and 200 for cosmetic reasons unrelated to patentability. No new matter has been added. Applicants
5 believe that the following comments overcome the rejections set forth in the March 31, 2003 Office Action and that the rejections should be withdrawn.

I. THE INVENTION

10 Generally, the present invention is a system for accessing electronic data via a familiar printed medium having a machine recognizable feature. The machine recognizable feature may be one of various embodiments including, but not limited to, a watermark, bar code,
15 invisible bar code, magnetic code, printed character, invisible icon, etc. An electronic signal is transmitted for processing when a machine recognizable feature is recognized. The processing results in the display of programming material related to the information contained
20 in the printed medium. Importantly, the present invention is designed to allow a user to access programming material related to the information contained in the printed medium to supplement the information provided by the printed medium.

II. THE EXAMINER'S REJECTIONS

A. 35 U.S.C. § 102(b)

The Examiner rejected claims 168-171 and 203 under 35 U.S.C. § 102(b) as being anticipated by Wellner U.S. Patent No. 5,640,193 (hereinafter referred to as "Wellner"). The Examiner opined that Wellner discloses a bar code scanner to scan data for decoding into a request for communication to a server. The Examiner indicated that information is also displayed to a user. Further, the Examiner explained that Wellner discloses the scanning of printed codes from various printed materials.

Next, the Examiner rejected claims 168 and 203 under 35 U.S.C. § 102(b) as being anticipated by Withnall *et al.* U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall"). Initially, the Examiner argued that Withnall discloses a transport system having a microprocessor-based, optical ticket reader that reads information from a printed ticket to determine and display the validity of the ticket. Also, the Examiner explained that a microprocessor-based ticket printer is used to issue bar-coded tickets. The Examiner then indicated that reference information is stored in memory which communicates with the ticket-checking means. The Examiner concluded therefrom that

Withnall discloses the invention claimed in claims 168 and 203.

B. 35 U.S.C. § 103(a)

The Examiner rejected claims 169-171 under 35 U.S.C. § 103(a) as being unpatentable over Withnall "in view of the general teachings of the prior art of record." (March 31, 2003 Office Action, p. 6). The Examiner admitted that the rejected claims differ from Withnall for disclosing various printed documents. The Examiner contended that all of these differences would have been obvious variations of Withnall.

To support the aforementioned conclusion, the Examiner cited Cassannas et al. U.S. Patent No. 4,492,164 (hereinafter referred to as "Cassannas"), Norman, Jr. U.S. Patent No. 5,126,547 (hereinafter referred to as "Norman"), and Drillick U.S. Patent No. 4,813,350 (hereinafter referred to as "Drillick"). The Examiner specifically cited Cassannas for describing cheques, bills for exchange, order forms, and bills to be protested. Norman was cited for describing checks, drafts, credit card receipts, and bank deposit slips. Finally, the Examiner cited Drillick for describing checks, invoice forms, and money orders.

Then, the Examiner rejected claims 172-202 under 35 U.S.C. § 103(a) as being unpatentable over Withnall "in

view of the general teachings of the prior art of record."

(March 31, 2003 Office Action, p. 7). The Examiner

admitted that Withnall fails to disclose a data link that carries certain types of data and video images, which the

5 Examiner believed to be obvious. For evidence, the

Examiner cited Thacher et al. U.S. Patent No. 5,083,271

(hereinafter referred to as "Thacher"), Ertz et al. U.S.

Patent No. 5,003,577 (hereinafter referred to as "Ertz"),

and Plummer U.S. Patent No. 4,992,824 (hereinafter referred

10 to as "Plummer"). Thacher and Ertz were cited for

describing various data links. Also, Plummer was cited for

disclosing data links that transmit image and video information.

Additionally, the Examiner rejected claims 204-227

15 under 35 U.S.C. § 103(a) as being unpatentable over

Withnall "in view of the general teachings of the prior art of record." (March 31, 2003 Office Action, p. 8). The

Examiner admitted that Withnall fails to disclose watermarks, invisible bar codes, magnetic codes, printed

20 characters, and invisible icons. The Examiner took

Official Notice that the use of these features as a data input source was known. For support, the Examiner cited

Konishi et al. U.S. Patent No. 5,237,156 (hereinafter referred to as "Konishi") and Younger U.S. Patent No.

5,151,687 (hereinafter referred to as "Younger"). The Examiner cited Konishi for disclosing a scanner for bar codes, magnetic characters, and character recognition. Younger was cited for acknowledging several types of "media-taped" materials.

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

A. 35 U.S.C. § 102(b)

The Examiner rejected claims 168-171 and 203 under 35 U.S.C. § 102(b) as being anticipated by Wellner. Applicants respectfully submit that the matter of the subject application predates Wellner. Particularly, Wellner has a priority date of August 15, 1994. The subject application, which now properly cross-references its parent applications in the amended specification, has an effective filing date of May 25, 1994. Consequently, Wellner cannot be cited against any claims of the subject application.

Also, the Examiner rejected claims 168 and 203 under 35 U.S.C. § 102(b) as being anticipated by Withnall. Applicants respectfully disagree. Specifically, Withnall does not disclose the programming material or the printed matter of the claimed invention. The programming material of the present invention is designed such that it can be

easily altered or updated at any time. As a result, a user will be provided with the most recently updated version of the associated information (or programming material) upon scanning a printed matter. Withnall, on the other hand,
5 scans a commuter ticket to ascertain a validity state associated with that ticket. However, at no point does Withnall provide more substantial programming material which includes various supplemental information corresponding to the printed matter. Therefore, Applicants
10 respectfully submit that Withnall does not disclose each and every element of claims 168 and 203 and therefore, does not anticipate these claims.

B. 35 U.S.C. § 103(a)

The Examiner rejected claims 169-171 under 35 U.S.C. §
15 103(a) as being unpatentable over Withnall in view of Cassannas, Norman and Drillick. Then, the Examiner rejected claims 172-202 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Thatcher, Ertz and Plummer. Additionally, the Examiner rejected claims 204-
20 227 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Konishi and Younger.

Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of the references cited against them. In order for a claimed

invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE § 2143-2143.03).

Initially, Applicants submit that there is no suggestion or motivation to modify or combine Withnall with any of the aforementioned references.

"Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (Emphasis in original).

The Examiner contended that it would have been obvious to combine the teachings of Withnall with the aforementioned references to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has pointed only to purported benefits of these

combinations without pointing to what motivation is provided by the references themselves. Applicants submit that no combination of these references would have been obvious to one of skill in the art at the time of
5 Applicants' invention, especially because no motivation or suggestion for combining these references exist within the references themselves. Specifically, Withnall discloses a system for easing the examination of commuter tickets for validity. This purpose is far removed from the intent of
10 Cassannas' printer that utilizes a platen roller, which prints via a stamp onto an information carrier. Withnall also relates in no way to Norman, which discloses checks having two strips that disclose machine readable account information. Additionally, Withnall has no apparent
15 relation to Drillick which discloses an apparatus for imprinting characters on financial documents. Moreover, Withnall has no apparent connection to Thacher, which discloses a scoring system for video game tournaments. Withnall also has no clear connection with Ertz's interface
20 between a video terminal and a voicemail system. Additionally, Withnall does not relate in any way to Plummer's system for printing on a photosensitive film via an LCD. Moreover, Withnall lacks relation to Konishi's apparatus for reading index information from images for

expediting image registration. Finally, Withnall does not show any relation to Younger, which discloses an apparatus that logs information pertinent to "media-taped" material. The differing purposes of these references have no overlap
5 in use, and therefore, would not provide one skilled in the art with a motivation or suggestion to combine these references. Thus, an inventive step must be performed for one skilled in the art to arrive at the idea of combining any features of Withnall with any features of the
10 aforementioned references.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejections actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for
15 obviousness under 35 U.S.C. § 103." *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong
20 temptation to rely on hindsight." *Orthopedic Equipment Co. v. United States*, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

25 "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way

so as to achieve the result of the claim in suit.
Monday morning quarterbacking is quite improper
when resolving the question of nonobviousness in
a court of law."

5

Applicants submit that the only suggestion or
motivation for the Examiner's combinations of references is
provided by the teachings of Applicants' disclosure. No
such suggestion or motivation is provided by the references
10 themselves; nor could there be in view of the difference in
subject matter and the corresponding goals thereof.

In view of the foregoing, base claim 168 is patentable
over any combination of Withnall and the aforementioned
references. The remaining rejected claims are dependent on
15 claim 168 and contain all of the limitations of this claim.
Therefore, these dependent claims are also patentable over
these references.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

Date: 6-23-2003



John W. Olivo, Jr.
Reg. No. 35,634
Ward & Olivo
382 Springfield Ave.
Summit, NJ 07901
908-277-3333

